

REMARKS

I. Status of the Claims

In the Office Action, Claims 55-61 were noted as pending in the application and were rejected. As a result of this response, Claims 55-58 have been canceled, Claims 59-61 remain pending, and new claims 62-67 have been added.

The Applicant respectfully requests reconsideration of the present application in view of the following remarks, which are responsive to the Office Action mailed June 13, 2008.

a. 35 U.S.C. § 103(a)

In the Office Action, Claims 55-61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Herman et al. (U.S. Patent No. 6,341,353) in view of Rogers et al. (U.S. Patent No. 6,018,719) (Office Action, page 2). For at least the following reasons, Applicant respectfully requests that the rejection of remaining pending Claims 59-61 under 35 U.S.C. § 103(a) be withdrawn.

i. Independent Claim 59

The Examiner has the burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). *Ex Parte Martin P. Hageman and Thomas J. Palus*, Appeal No. 2000-1514, Application No. 09/038,450 (citing *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)); *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only if the Examiner satisfies this initial burden does the burden of coming forward with evidence shift to the Appellant. *Id.* The Examiner can satisfy this burden by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

A prima facie case of obviousness requires: (1) a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; (2) a reasonable expectation of

success; and (3) the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Fine*, 87 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); MPEP § 2142, 8th Ed., Rev. 4. Furthermore, rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be explicit analysis including some rational underpinning to support the legal conclusion of obviousness. *K.S.R. International Co. v. Teleflex, Inc.*, et al., 550 U.S. 14 (April 2007), citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

Objective indicia of non-obviousness in Rule 1.1.32 declarations were held to defeat proper prima facie obviousness rejections in *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) and in *In re Sernacker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Objective indicia of non-obviousness include industry recognition and commercial success of the invention. Applicant herein provides a declaration under Rule 1.132 by Jim Nadler, V.P. Marketing and Business Development of the Applicant, stating the invention as claimed in claim 59 is commercially successful based on the recognition of the superior results obtained by providing electronic receipts using an electronic receipt generator enabling access to sales data in real time. Applicant hereby submits that such recognition would not be afforded to an obvious invention, as such recognition as described in the accompanying Declaration originated from industry peers of the Applicant. For these reasons, Applicant submits that dependent claim 59 is not obvious in light of Herman in view of Rogers.

ii. Dependent Claims 60 and 61

Claims 60 and 61 depend, respectively, from independent Claim 59 and include all of the recitations of their base claims and any intervening claims plus their additional recitations that further distinguish the art applied in the rejection. As the Court noted in *In re Fine*, "dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious." 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Therefore, Applicant respectfully

submits that because independent claim 59 is now nonobvious, remaining claims 60 and 61 are also nonobvious and are now in a form for allowance.

II. New Claims

Applicant respectfully requests to add new claims 62-67. Applicant submits that new independent claims 62 and 66 are non-obvious over Herman in view of Rogers at least because, similar to claim 59, each new independent claim recites as a limitation providing electronic receipts using an electronic receipt generator enabling access to sales data in real time, or equivalent. Applicant submits that new dependent claims 63-65 and 67 are non-obvious at least because they each directly or indirectly depend from an allowable base claim.

III. Conclusion

In light of the remarks above, Applicant respectfully submits that the application is in condition for allowance and respectfully requests that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 14-0629.

Respectfully submitted,

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